



PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Sprunck, et al.
Serial No. : 09/899,595
Filed : July 5, 2001
For : PROMOTERS FOR GENE EXPRESSION IN
CARYOPSES OF PLANTS
Examiner: R. Kallis
Group Art Unit : 1638

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Name of Applicant, Assignee or Registered Representative

Marilyn M. Brogan

Signature

November 6, 2002

Date of Signature

**RESPONSE TO OFFICE ACTION WITH REQUEST FOR
WITHDRAWAL OF RESTRICTION REQUIREMENT AND EXTENSION OF TIME**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed on October 3, 2002, setting a one month term for reply. Pursuant to 37 C.F.R. §§1.136(a), a one-month extension of the period for reply, i.e., to up to and including December 3, 2002 is requested. A check for \$110.00 is enclosed in payment of the fee under 1.17(a). The Commissioner is authorized to charge any additional required fee for this extension of time or any other fee occasioned by this paper, or credit any overpayment in such fees, to Deposit Account No. 50-0320.

The Office Action required election from among:

Group I: Claims 1-13 and 15, drawn to a method of caryopsis-specific gene expression, classified in class 800, subclass 288; and

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Group II: Claims 1-12, 14 and 16, drawn to a method of caryopsis-specific gene suppression, classified in class 800, subclass 285.

Group I is elected with traverse for further examination in this application. Applicants retain the right to file divisional applications to non-elected subject matter. Reconsideration and withdrawal of the restriction requirement are requested in view of the remarks herein.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

The assertion in the Office Action that the claims of Groups I and II are unrelated is misguided. The present invention relates to a nucleic acid molecule with the function of a caryopsis-specific promoter (for example, claims 1 and 2). This promoter may be introduced into an expression cassette (claim 3), a vector (claims 4 and 5), a host cell (claims 6-8), or a plant or its propagation or harvested material (claims 9 and 10). The use of the promoter of the invention for the caryopsis-specific expression (claims 13 and 15) or suppression (claims 14 and 16) of genes in genetically modified plants are only two embodiments of the same invention. The inventive concept is the caryopsis-specific promoter provided, for the first time, by the instant invention. The claims of Groups I and II are not independent or distinct, and therefore are not properly subject to restriction.

Further, the Examiner's attention is respectfully directed to MPEP § 808.02 which states, “... restriction is not (emphasis added) required unless one of the following reasons appears:

1. Separate classification;
2. Separate status in the art; or
3. Different field of search . . .”

None of those reasons apply here. The claims of the two Groups are classified in the same class. Caryopsis-specific gene expression and suppression using the same promoter certainly do not have separate status in the art. And, it is submitted that any search for caryopsis-specific gene regulation using the claimed promoter will encompass both expression and suppression of the gene. Therefore, it is respectfully submitted that it would not place an

unnecessary burden on the Examiner to search and examine both groups together, as a search for the Group I methods would necessarily include the Group II methods.

The Office Action further requires that a single nucleic acid sequence be elected.

Applicants elect SEQ ID NO:1 with traverse. Contrary to the assertion in the Office Action, the sequences represented by SEQ ID NOS:1-10 are, in fact, members of a single structurally and functionally related genus. SEQ ID NO:1 comprises the complete promoter of the invention, whereas SEQ ID NOS:2-10 constitute parts thereof. They simply cannot be considered independent and patentably distinct, as each of SEQ ID NOS:2-10 is found within SEQ ID NO:1.

The result of the present restriction requirement is inefficiency and unnecessary expenditures by both the Applicants and the PTO and extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the claims of Groups I and II are inextricably linked, and the requisite showing of serious burden has not been made in the Office Action. These factors mitigate against the restriction as it currently stands.

Hence, it is evident that the pending claims are related, and in view of the foregoing, reconsideration and withdrawal of the requirements for restriction and sequence election, and favorable consideration of the claims on the merits are respectfully requested.

Respectfully submitted,

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